

## REMARKS

The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

**35 U.S.C. §103(a) Rejection – Felcman and Douglas**

The Examiner has rejected claims 17-37 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,830,394 issued to Felcman et al. (hereinafter referred to as "Felcman") in view of U.S. Patent No. 5,156,049 issued to Douglas (hereinafter "Douglas").

The Applicants respectfully submit that: (a) Felcman and Douglas should not be combined; and (b) even if Felcman and Douglas are combined, which does not even seem appropriate, the combination still does not teach or suggest all of the limitations of the independent claims.

**(a) Felcman and Douglas Should Not Be Combined**

Felcman and Douglas are from non-analogous arts. Felcman pertains generally to computer systems and more specifically to a keyboard having a track ball mechanism and a scroll mechanism (see e.g., the Title and Background of the Invention). In contrast, Douglas pertains to a manual input system for automotive test equipment (see e.g., the Title and Field of the Invention). Track ball and scroll mechanisms of computer systems and automotive test equipment are non-analogous arts.

As discussed in the MPEP 2141.01(a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art: *"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the*

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*invention was concerned."* *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The problems addressed in Douglas are not reasonably pertinent to and would not logically have commended themselves to an inventors attention when he/she was considering the problems addressed in Felcman. A person skilled in the art of design of computers and the like would typically have very little knowledge, if any, of the art of design of automotive test equipment, and would not typically look to that field for design guidance. The Examiner has not provided sufficient reason why a person skilled in the art of computer systems would look to the field of automotive test equipment. Further an inventor could not possibly be aware of every teaching in every art. *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979).

Secondly, there is no suggestion or motivation to combine Felcman and Douglas. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. There is no such suggestion or motivation.

The Examiner has merely asserted on page 3 of the present Office Action that "*it would have been obvious to one having ordinary level of skill in the art at the time of the invention to allow the ridged wheels or the usage of the ridges, as taught by Douglas, to be used in a device or to be included on the wheel device similar to that which is taught by Felcman et al. in order to provide the user with traction when operating the wheel device thereby allowing the device to be gripped more securely*". Applicants respectfully submit that the mere motivation of providing traction is insufficient motivation for

incorporating the manual input devices 13, 15, 17 of Douglas into Felcman as horizontal wheels to receive user input into the claimed apparatus.

An invention is not obvious where the Examiner fails to provide a suggestion even if the prior art "could" have been combined. The modification is not obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Accordingly, Felcman and Douglas should not be combined.

**(b) Any Combination of Felcman and Douglas Does Not Teach or Suggest All Claim Limitations**

Even if Felcman and Douglas are combined, which does not even seem appropriate for the reasons discussed above, the combination still does not teach or suggest the limitations of the independent claims.

Claim 17 recites an apparatus comprising:  
a keyboard having a space bar and keys;  
a horizontal wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard to receive user input, wherein the wheel includes ridges;  
a tracking device positioned below the space bar to receive user input to direct a cursor displayed on a display, wherein the tracking device is closer to the space bar than the wheel;  
a right mouse button, wherein the right mouse button is positioned to the right of the wheel;  
a left mouse button, wherein the left mouse button is positioned to the left of the wheel.

No combination of Felcman and Douglas teaches or reasonably suggests the claimed apparatus including the claimed horizontal wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard to receive user input.

The Examiner has admitted that Felcman fails to teach the usage of a horizontal wheel, wherein the wheel includes ridges. Applicants respectfully agree.

However, the Examiner has stated that Douglas teaches horizontal wheel devices (13, 15, 17) capable of being rotated horizontally relative to a surface for interacting with a visual display including ridges (see Figure 5). Applicants respectfully disagree.

The manual input devices 13, 15, 17 of Douglas are not horizontal wheels and do not rotate horizontally relative to a top surface. FIG. 2 of Douglas shows the manual input devices 13, 15, 17. Column 3, lines 27-28 make it clear that FIG. 2 is a front elevation of the display panel/manual input portion of the balancer. It is not a top planar view. In this elevation view, the shown surface is a vertical surface, not a top surface. Furthermore the manual input devices 13, 15, 17 are clearly not horizontal wheels and do not rotate horizontally.

Furthermore, it would not be appropriate to modify the manual input devices 13, 15, 17 so that they would be horizontal wheels and rotate horizontally relative to a top surface of the keyboard of a laptop or like apparatus falling within the scope of the claims, since those skilled in the art of designing such apparatus would find it difficult to produce a commercially useful apparatus using the manual input devices 13, 15, 17. FIG. 5 of Douglas shows a perspective view of the manual input devices 13. As plainly shown, the manual input device 13 has the shape of a truncated cone with the apex cut off. It is well known in the art of designing laptop computers, and other apparatus falling within the scope of the claims, that it is often appropriate to reduce device thickness. In contrast, the manual input device 13 if employed as a horizontal wheel as proposed by the

Examiner would not be thin. Rather, the height of the manual input device 13 (the height of the truncated cone) and would add significant unwanted and undesirable thickness to the apparatus. In practice, this would likely severely limit the commercialization of a laptop or like apparatus. These are a few reasons why it would not be obvious to combine Felcman and Douglas as proposed by the Examiner.

Furthermore, it is plain to see that the truncated end of the cone is apparently very small. Accordingly, even if the manual input device 13 was made thinner, or the height of the cone reduced, it may tend to be difficult to easily rotate the manual input device 13 using only the small end surface. Furthermore, the features which the Examiner interprets as the claimed ridges are clearly on the sides of the truncated cone and therefore would not be of much help if the manual input device were made thinner and/or embedded nearly flush with the top surface. These are a few reasons why it would not be obvious to combine Felcman and Douglas as proposed by the Examiner.

Accordingly, for at least one or more of these reasons, claim 17 and its dependent claims are believed to be allowable. In dependent claims 20 and 31, and their respective dependent claims, are believed to be allowable for similar reasons.

#### **(c) Dependent Claims Believed To Be Further Allowable**

Claim 28 recites wherein the tracking device is in the center of the wheel. Any combination of Felcman and Douglas does not teach or suggest this limitation.

Claim 29 recites in part wherein rotation of the wheel in one direction scrolls down a displayed document, and wherein rotation of the wheel in another direction scrolls up the displayed document. Claim 39 recites similar limitations. Any combination of Felcman and Douglas does not teach or suggest this limitation.

Claim 38 recites wherein the ridges are on an upper surface of the horizontal wheel. Claim 40 recites similar limitations. Any combination of Felcman and Douglas does not teach or suggest such limitations.

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**Conclusion**

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

**Request For Telephone Interview**

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

**Request For An Extension Of Time**

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

**Charge Our Deposit Account**

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 6/1/06

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